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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,276	06/24/2002	Klaus Goebel	112740-526	1704
29177	7590	02/23/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			CHIANG, JACK	
			ART UNIT	PAPER NUMBER
			2642	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/069,276	GOEBEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jack Chiang	2642	

**- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 27 September 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 11-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 11-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

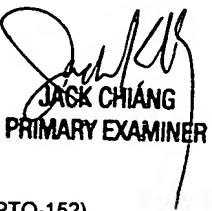
#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



JACK CHIANG  
PRIMARY EXAMINER

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**NOTE:** to assist applicant understanding the examiner's reading of the Imai reference, a "hinge line" marked in red ink had been added in Imai's figs. 2 and 5A, see also the attached sheets at the end of this Office Action.

### **CLAIMS**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Imai (EP 0704446 A2).

Regarding claim 11, Imai shows a telephone comprising:

A first part (101);

A display and input device which is configured as a touch screen (103);

A second part (102) which has a first operation position covering the screen (fig. 5a), and a second operation position exposing the screen (fig. 2);

A telephone receiver (above 109 in fig. 5a) which is positioned over a surface (below the "hinge line" shown in figs. 2 and 5A) of the touch screen (103); and

Additional input parts (104 in figs. 2, 5a).

Regarding claims 12-19, Imai shows:

The touch screen (103);

the mechanical keypad and its pressure pin (104);  
the recesses (spaces for keys 104 in fig. 5b);  
a phone input mode (fig. 5a);  
the input keypad (104) is independent of the touch screen (103) (note: 103 and 104 are physical independent elements);  
a pivot (hinge connecting 101, 102);  
the first exposed displaced position and the second covered displaced position (figs. 2, 5a);  
a transparent window (109); and  
a change-over switch (106, 107).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imai in view of Iwata et al. (US 5646649).

Regarding claim 20, Imai shows an input pin (105).

Imai differs from the claimed invention in that it does not explicitly mention that there is a recess for holding the input pin.

However, if a device needs an input pin (stylus pen), then it is most likely that the device would have a recess for holding the input pin, because the input pin needs to be stored

away after finish using it. This is also taught by Iwata, such as the input pin (50) and the recess (51).

Hence, if it is found that Imai does not have a recess for the input pin (105), then it would have been obvious for one of ordinary skill in the art to modify Imai with a recess for holding the input pin with/without the teaching of Iwata, because the input pin needs to stored away, and it is common seen that devices having an input pin usually have a recess for holding the input pin.

### **ARGUMENT**

5. In response to the remarks (pages 4-5), applicant mainly argues that "... the telephone receiver disclosed in the Imai reference ... *is not* over the surface of the associated touch screen...".
6. The examiner disagrees. After a careful review of the Imai's reference, it appears that "the telephone receiver disclosed in the Imai reference ... *is* over the surface of the associated touch screen...", see area just below the "hinge line" marked in figs. 2 and 5a.
7. Applicant's arguments with respect to claims 11-20 have been considered but are moot in view of the new ground(s) of rejection.
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

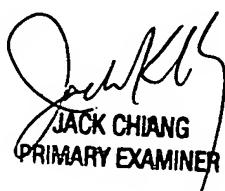
Art Unit: 2642

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JACK CHIANG  
PRIMARY EXAMINER

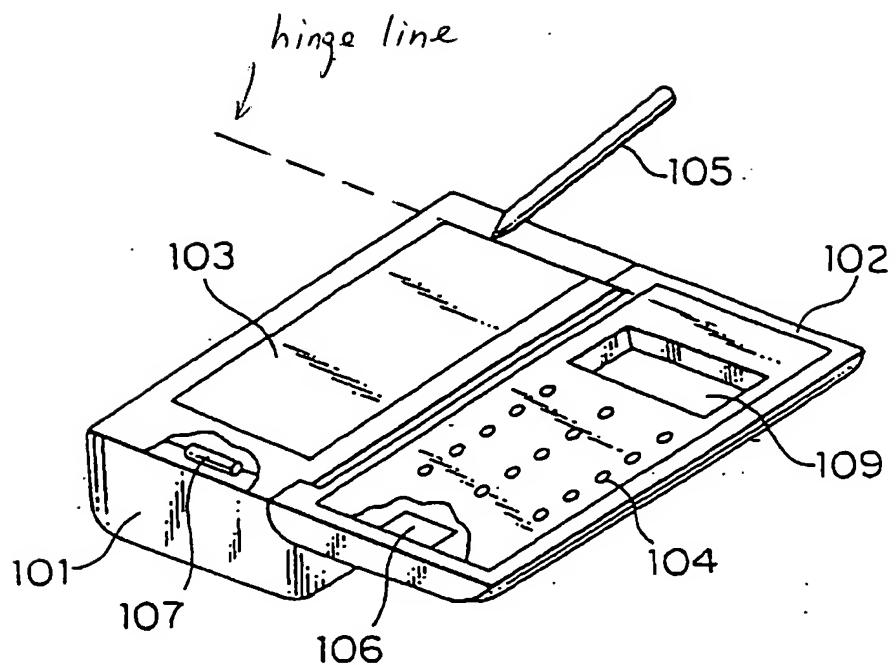


FIG. 2

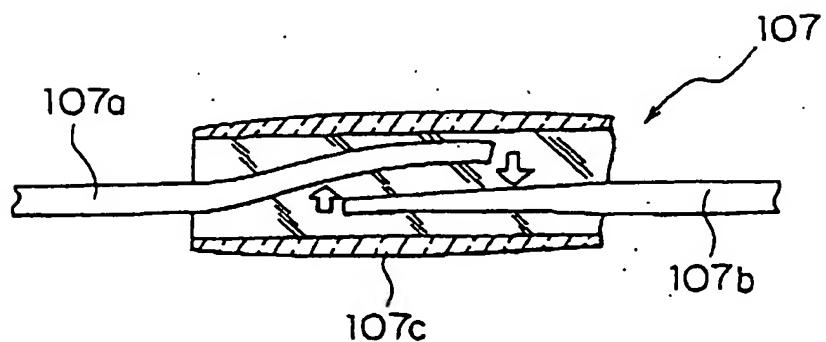


FIG. 3

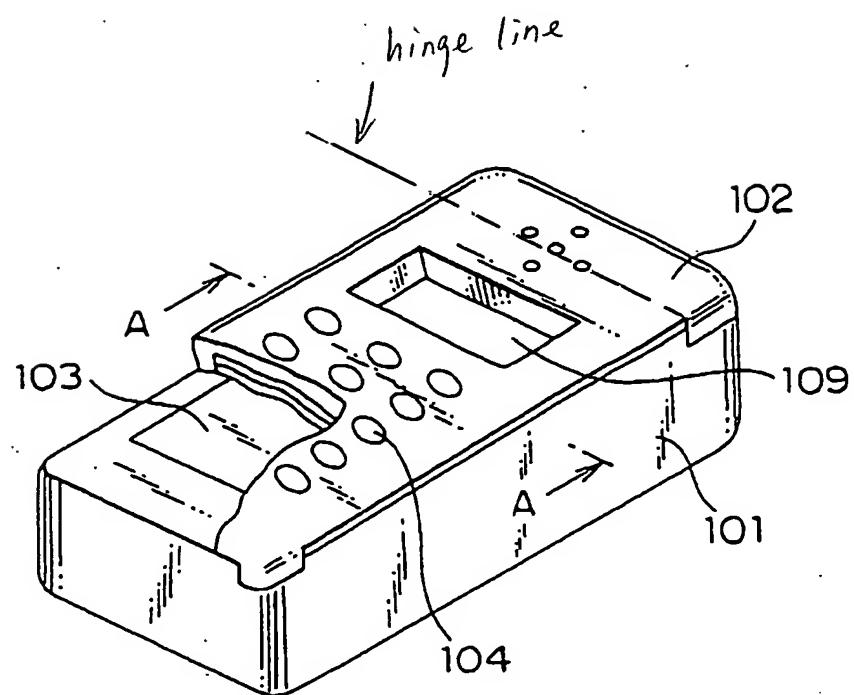


FIG. 5A

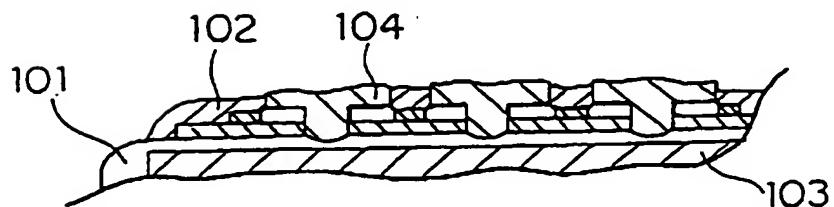


FIG. 5B